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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

9407-40/GB920010095US1

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on April 24, 2006

Signature

Typed or printed
name

Erin A. Campion

Application Number

10/081,500

Filed

February 22, 2002

First Named Inventor

John Owlett

Art Unit

2131

Examiner

Laforgia, Christian A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

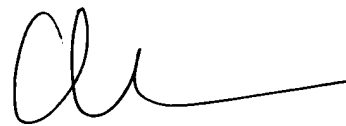
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attorney or agent of record.

Registration number 48,568☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

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Typed or printed name

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Telephone number

April 24, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE – EXAMINING GROUP 2131**

Attorney's Docket No. 9407-40/GB920010095US1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: John Owlett

Serial No: 10/081,500

Filed: February 22, 2002

For: **METHOD AND SYSTEM FOR AUTHENTICATION OF A USER**

Confirmation No.: 1505

Group Art Unit: 2131

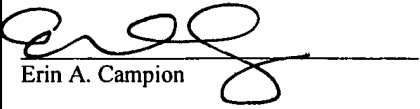
Examiner: Laforgia, Christian A.

Date: April 24, 2006

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Erin A. Campion

**REASONS IN SUPPORT OF APPLICANT'S PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program, which was extended until further notice on January 10, 2006.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicant requests that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 09-0457.

REMARKS

Applicant hereby requests a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed January 24, 2006 (hereinafter "Final Action") and the Advisory Action mailed April 12, 2006 (hereinafter "Advisory Action"). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Application Publication No. 2002/0034301 to Andersson (hereinafter "Andersson"), in view of United States Application Publication No. 2004/0202328 to Hara (hereinafter "Hara") and/or United States Patent No. 6,072,875 to Tsudik (hereinafter "Tsudik"). Applicant respectfully submits that many of the recitations of the pending claims are not met by the cited references for at least the reasons discussed herein and in Applicant's previously filed Requests for Reconsideration of November 9, 2005 and March 23, 2006 and that a *prima facie* case of obviousness has not been made by the Office Action of August 9, 2005 (hereinafter "the First Action"), the Final Action and/or the Advisory Action. Therefore, Applicant respectfully requests review of the present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicant will only discuss the recitations of the independent Claim 1.

Both the First Action and the Final Action (referred to collectively herein as "Office Actions") state that Andersson teaches all the recitations of Claim 1 (and corresponding Claims 13 and 14) except for "adding a spoiler to the challenge and encrypting the combined spoiler and challenge." *See e.g.*, First Action, page 2. However, the Office Actions points to Hara as providing the missing teachings. *See e.g.*, First Action, page 3. In fact, the cited portion of Andersson discusses a conventional encryption system that includes sending a challenge to the requesting party. *See* Andersson, page 3, paragraph 40. This type of conventional encryption system is discussed in the Background of the present application. *See* Figure 2 and corresponding text. Applicant does not dispute that the use of a challenge as discussed in Andersson is known. However, Claim 1 recites "**adding a spoiler** to the challenge; encrypting the **combined spoiler and challenge** using a private key of an asymmetric key pair and sending a response to the authenticating entity **in the form of the encrypted combined spoiler and challenge**." Nothing in Andersson discloses or suggests at least these recitations of Claim 1. Furthermore, Hara does not provide the missing teachings.

In particular, the cited portion of Hara (paragraphs 83 and 84) discusses filling in bits in an IP datagram with "1's" so as to create a 64 bit datagram, which is better suited for encryption. Thus, Hara basically discusses adding place holders in the IP datagram. Nothing in Hara

discusses the addition of a "spoiler" as recited in Claim 1. In fact, the addition of 1's discussed in Hara would not provide any added level of security as a "spoiler" that is always all 1's is easy to figure out. Accordingly, Hara does not provide the missing teachings. Accordingly, Claim 1 is patentable over the cited combination for at least these reasons.

Furthermore, there is no motivation or suggestion to combine the cited references as suggested in the Office Actions. The motivation provided in the Office Actions (*See, e.g.*, First Action, page 3) is a motivation based on "subjective belief and unknown authority", the type of motivation that was rejected by the Federal Circuit in *In re Sang-su Lee*. In other words, the Office Actions do not point to any specific portion of the cited references that would induce one of skill in the art to combine the cited references as suggested in the Office Actions. In fact, the Office Actions misinterpret the cited portion of Hara. Nothing in the cited portion of Hara states that the padding makes the encryption "stronger", only that a length of 64 bits is "better suited" for encryption, *i.e.*, easier to encrypt as it is a more standard length. Again, as discussed above, adding all 1's is not going to strengthen the encryption, as it would be easy to predict. Accordingly, the statements in the Office Actions with respect to motivation does not adequately address the issue of motivation to combine as discussed in *In re Sang-su Lee*. Thus, it appears that the Office Actions gain their alleged impetus or suggestion to combine the cited references by hindsight reasoning informed by Applicant's disclosure, which, as noted above, is an inappropriate basis for combining references.

Furthermore, Andersson discusses network authentication that uses a conventional challenge responsive to a request. *See* Andersson, page 3, paragraph 40. Hara, on the other hand, discusses a data transmission method including encryption where the header is padded with 1's to create a 64 bit block that may be well suited for encryption. *See* Hara, paragraphs 83 and 84. Furthermore, there is no discussion of a "challenge" in the cited portion of Hara. Nothing in the cited references or the art itself would motivate a person of skill in the art to combine the network authentication application of Andersson with the data transmission application of Hara. Furthermore, even if Andersson and Hara could be properly combined, the combination of Andersson and Hara would not teach the recitations of the pending claims for at least the reasons discussed above.

The Final Action states:

The Applicant defines a spoiler in page 8 of the specification as "be[ing] added to the challenge as a prefix or a suffix and the authenticating entity extracts the challenge by counting the number of bytes from the beginning or end of the combined spoiler and challenge." Hara discloses adding padding to data and then encrypting the data along with padding the data, because the data is then better suited for encryption (see paragraphs [0083] and [0084]).

See Final Action, page 2. First, the cited portion of Applicant's specification is not the definition of a spoiler as used therein. The cited portion of Applicant's specification is found in the Summary of the Invention, and discusses features of some embodiments of the present invention. The spoiler according to some embodiments of the present invention is added to a challenge to enhance the authentication of a user, thus, providing more security to the users of the system. Applicant does not see how "adding padding to data", *i.e.* adding a bunch of 1's to the IP datagram, to create a 64 bit datagram, which is easier to encrypt, teaches a spoiler as recited in the claims of the present application. Nothing in Applicant's specification even suggests the addition of bits simply to normalize the encryption process. In fact, the addition of 1's discussed in Hara would not provide the added level of security provided by a "spoiler" according to some embodiments of the present invention, as the padding is always all 1's and, therefore, easy to figure out. Accordingly, Applicant submits that the cited combination does not teach adding a spoiler to the challenge as recited in the claims of the present invention for at least these additional reasons.

Responsive to Applicant's arguments that there is no suggestion to combine the references, the Final Office Action states:

In this case, the references provide a teaching, suggestion and motivation for combining the references. As disclose in Hara, in particular paragraph [0084], adding padding makes the data to be encrypted better suited for encryption.

See Final Action, page 3 (emphasis added). As discussed above, the "spoiler" as recited in the claims of the present application does not just "pad" the data to simplify the encryption process.

The Final Action further misinterprets Applicant's arguments as the Final Action states that Applicant argued that "the question of motivation to add padding is based on subjective

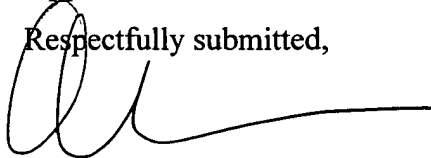
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Filed: February 22, 2002
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belief and unknown authority." *See* Final Action, page 3. In fact, Applicant's argument is that the motivation to combine the references is not found within the references themselves or the art and, thus, the motivation to combine must be found in Applicant's disclosure, which is improper. Furthermore, even if the teaching of padding found in Hara were combined with the teachings of Andersson, the combination does not teach the recitations of the claims of the present application.

Finally, the Advisory Action states that "the features upon which applicant relies, such as a spoiler as defined by the specification, are not recited in that rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims..." *See* Advisory Action, Continuation Sheet. Applicant respectfully submits that Applicant only pointed to the specification to clarify statements made in the Final Action. In particular, the Final Action pointed to the summary of the invention for the definition of spoiler and Applicant merely pointed the Examiner to the proper definition. In fact, it was the Final Action that was trying to read limitations into the claims from the specification.

Accordingly, for at least these reasons, Applicant respectfully submits that the First Action, Final Action and Advisory Action fail to provide a *prima facie* case of obviousness and, therefore, requests that the present application be reviewed and that the rejections be reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Elizabeth A. Stanek', with a long horizontal flourish extending to the right.

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